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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,837	08/27/2001	Pony Huang	82318	1094

20529 7590 12/04/2002

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EXAMINER

KOVAL, MELISSA J

ART UNIT	PAPER NUMBER
2851	

DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

	Application No.	Applicant(s)
	09/938,837	HUANG ET AL.
Examiner	Art Unit	
Melissa J Koval	2851	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

THE MAILING DATE OF THIS COMMUNICATION. In no event, however, may a reply be timely filed

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on \_\_\_\_.  
     2b) This action is non-final.  
 2a) This action is FINAL.  
     3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1-3 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) 1-3 is/are rejected.  
 7) Claim(s) \_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 09 April 2002 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 11) The proposed drawing correction filed on \_\_\_\_ is: a) approved b) disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.  
 12) The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

Priority under 35 U.S.C. §§ 119(a)-(d) or (f).

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) All b) Some \* c) None of:  
         1. Certified copies of the priority documents have been received.  
         2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
         3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.  
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) The translation of the foreign language provisional application has been received.  
 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_.

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## DETAILED ACTION

### *Priority*

Acknowledgment is made of applicant's claim for foreign priority based on five applications filed in Taiwan on August 28, 2000. It is noted, however, that applicant has not filed certified copies of the Taiwanese applications as required by 35 U.S.C. 119(b).

### *Information Disclosure Statement*

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. The examiner is specifically referring to publication number 224688.

### *Drawings*

The corrected or substitute drawings were received on April 9, 2002. These drawings are approved.

### *Specification*

Applicant is reminded of the proper content of an abstract of the disclosure. A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly

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those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it contains grammatical errors that may have occurred during translation into English. Correction is required.

See MPEP § 608.01(b).

A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

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The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested:

-- Film scanning device for receiving either strip film or a slide mount utilizing a single photographic sensor. --

### ***Claim Objections***

Claims 1-3 are objected to because of the following informalities: The claims are replete with grammatical errors. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitations "The first opening" and "the body" in line 2, "the developed strip film" in lines 2 and 3, "The second opening" in line 4, "The third opening" in line 6, "the slide mount" and "the direction vertical to the direction" in line 7, "the two sides of the body" in line 9, "the actuating mechanism" in lines 9 and 10, "the path of a strip film" in line 10, and "the pictures of the strip film" in line 12. There is insufficient antecedent basis for these limitations in the claim.

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Also with respect to claim 1, applicant may want to consistently refer to either "the developed strip film" or "the strip film" without mixing phraseology throughout the claim. The phrase "and/or" in line 13 of claim 1 is vague and indefinite because it suggests two different embodiments in a single claim.

With respect to claim 2, the phrase "the front/behind the direction of the moving direction" both lacks antecedent basis and suggests two different embodiments in a single claim.

With respect to claim 3, lines 4 and 5, respectively, "the link mechanisms" and "the same mechanic actuated timing belt or gear" lack antecedent basis and suggest multiple embodiments. Additionally, claim 3 is rejected for the same reasons already applied to rejected claim 2.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by

Wirt et al.

Refer to Figure 1 of Wirt et al., for example.

Claim 1 sets forth: "A film scanning device that includes:

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The first opening was located at the body (housing 31) which for inserting the developed strip film (gate 60);

The second opening was located at the body which is an exit for the strip film which was inserted into the first opening (Exit ports 62 and 63.);

The third opening was located in front of the body which is for inserting and pulling out the slide mount following the direction vertical to the direction which the strip film was moved (primary gate 12);

An actuator which was located at the two sides of the body for actuating the actuating mechanism to move the strip film following the path of a strip film was carried

(microswitches 70 and 71);

A photographic sensor which took the pictures of the strip film was inserted from the first opening and/or the slide mount was inserted from the third opening (video sensor 23); and

A projecting light which was used to project the pictures from the photographic sensor (Refer to illumination source 26 and column 3, lines 57 through 65)."

With respect to claims 2 and 3 refer to arms 72 and 74.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Maeda et al.

Refer to Figures 1 through 3, 9 through 11, 13, 14 and 27 of Maeda et al., for

example.

Claim 1 sets forth: "A film scanning device that includes:

The first opening was located at the body which for inserting the developed strip film (carrier inlet 21);

The second opening was located at the body which is an exit for the strip film which was inserted into the first opening (Carrier inlet 21 has an opposite opening that functions as an outlet. See Figures 9 and 14);

The third opening was located in front of the body which is for inserting and pulling out the slide mount following the direction vertical to the direction which the strip film was moved (Refer to Figure 13 and inlet 104);

An actuator which was located at the two sides of the body for actuating the actuating mechanism to move the strip film following the path of a strip film was carried (Refer to carrier detecting switch 28 shown in Figure 27);

A photographic sensor which took the pictures of the strip film was inserted from the first opening and/or the slide mount was inserted from the third opening (Refer to column 5, lines 26 through 37, wherein a CCD, CCD 72 as shown in Figure 10, serving as a solid state electronic imaging device is described); and

A projecting light which was used to project the pictures from the photographic sensor (Refer to lighting lamp 31 and imaging optical system 71 shown in Figure 10)."

Maeda et al. shows all of the elements of claim 1 with the exception of an actuator on both sides of a body. Carrier detecting switch 28 is located on only one side of inlet 21 and functions in tandem with the manual insertion of the film strip or the mechanical insertion of the slide mount to perform the operation desired. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use carrier detecting switches on both sides of inlet 21 as, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

With respect to claims 2 and 3, the claimed transit rollers are not necessary for the device shown by Maeda et al. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a simple manual sliding system, as shown by Maeda et al., in place of the transit sliding rollers claimed, since it has been held that omission of an element and its function in combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa J Koval whose telephone number is (703) 308-4801. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russell Adams can be reached on Monday through Thursday at (703) 308-2847. The fax phone numbers for the organization where this application or proceeding

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is assigned are (703) 305-3431 for regular communications and (703) 308-7382 for

After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

MJK

November 30, 2002

  
M.J.K.  
SEARCHED  
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NOV 30 2002  
USPTO-COMPUTER SYSTEMS  
RECEIPT FILED NOV 30 2002  
RECEIVED NOV 30 2002  
RECEIVED NOV 30 2002